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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/367,040      | 08/06/1999  | ALEXANDRA BROWNFIELD | MERCK2009           | 3802             |

23599 7590 05/06/2002

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EXAMINER

PAULRAJ, CHRISTOPHER

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1773

DATE MAILED: 05/06/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 17

# Office Action Summary

Application No.

09/367,040

Applicant(s)

BROWNFIELD ET AL.

Examiner

Christopher G. Paulraj

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 7-9 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The request filed on February 19, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/367,040 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment filed on December 18, 2001 has been entered. Claims 1-5, 7-9, and 11-14 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5, 7-9, and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 11 have been amended to recite that "the paper comprises, as absorber material, a single layer inorganic platelet form substrate having . . . particle size distribution of 1  $\mu\text{m}$  to 60  $\mu\text{m}$  . . ." (emphasis added). Claim 12 recites that the "absorber material is applied in a single coat layer." The specification, as originally filed, did not disclose that the absorber material was to be a single layer, applied in a single coat layer, or that it was

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present with a particle size distribution of 1  $\mu\text{m}$  to 60  $\mu\text{m}$ . These features are considered to be new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5, 7-9, and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language suggests that the limitation of "a single layer platelet form substrate" refers to the particulate absorber material that is present within the laser-markable paper. However, Applicants arguments state that the reference to the single layer is to the paper, as a whole, and not just to the individual particles. The claims are indefinite because it is unclear what the "single layer" is referring to.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4238378 A for the reasons substantially set forth in item 2 of the Office Action mailed June 18, 2001 (paper no. 11).

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9. Claims 1, 7, 9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gusi (U.S. Patent 5,773,494) for the reasons substantially set forth in item 3 of the Office Action mailed June 18, 2001 (paper no. 11).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gusi in view of Williams (U.S. Patent 5,206,280) for the reasons substantially set forth in item 4 of the Office Action mailed June 18, 2001 (paper no. 11).

***Response to Arguments***

12. Applicant's arguments filed December 18, 2001 have been fully considered but they are not persuasive.

13. With respect to the DE 423878 reference, Applicants argue that it does not read on the claims because the limitation of a single layer substrate distinguishes the claimed invention from the reference's teaching of applying a first and second coat onto a paper substrate. This is not persuasive because the coatings can contain C black or pearlescent pigments, which are not disclosed to be coated. The Examiner considers these pigments to be single layers. Furthermore, the transitional phrase "comprising"

does not place any limitations on what may be added to the platelet-form substrate.

The metal-oxide coating can be considered as a distinct component, which is added onto the mica flake. The mica flakes, in and of themselves, would satisfy the requirement of a single layer. The open-ended claim language of “comprising” does not preclude the presence of additional metal-oxide coatings.

14. With respect to the Gusi reference, Applicants argue that the reference’s teaching of urea-based resin and cellulose-based reinforcing material does not render the absorber material to be inorganic, as required by the instant claims. This is not considered to be persuasive because the term inorganic is considered to refer to the absorber material and not the paper layer, as a whole. Paper, by its very definition, is made of organic cellulose-based material. The claims do not require the entire paper to be inorganic – just the particulate absorber material. The titanium dioxide particles disclosed by Gusi meet the requirements of a single layer inorganic platelet-form substrate.

15. With respect to the Williams reference, Applicants argue that the disclosed pigments include both organic and inorganic components. This is not considered to be persuasive because the claims do not require that the paper comprises exclusively inorganic absorber materials. Applicants also argue that there is no motivation to combine this reference with the teachings of Gusi. This is not persuasive because, as the Examiner had previously indicated in the last Office Action, one skilled in the art would be so motivated in order to increase the optical density of the coating and

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produce a whitening effect without adversely affecting the laser markability of the composition.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Paulraj whose telephone number is (703) 308-1036. The examiner can normally be reached on Monday-Friday, 8am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

cgp  
May 1, 2002



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SUPERVISORY PATENT EXAMINER  
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